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In re Application of
SAWHILL, Robert Arthur, et al.
Application No.: 09/786,740
PCT No.: PCT/SG98/00068
Int. Filing Date: 09 September 1998
Priority Date:
Attorney Docket No.: A34089 PCT USA
For: INTERFACE DEVICE BETWEEN
TESTING EQUIPMENT AND
INTEGRATED CIRCUIT

DECISION ON
PETITION UNDER
37 CFR 1.137(b)

This is in response to applicants' "Petition For Revival of an International Application," filed in the United States Patent and Trademark Office (USPTO) on 14 March 2005.

BACKGROUND

On 09 September 1998, applicants filed international application PCT/SG98/00068. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 16 March 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 04 April 2000, within nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 09 March 2001.

On 08 March 2001, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 23 April 2001, USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge for late filing of the oath or declaration were required. The NOTIFICATION set a two-month extendable period for reply.

On 23 October 2001, applicants filed "Petition Pursuant to 37 C.F.R. §1.47(a)" accompanied by, *inter alia*, a petition for a four-month extension of time, the fee for a four-month extension of time, the Notification of Missing Requirements dated 23 April 2001, an assignment, a combined declaration and power of attorney and a declaration under 37 CFR §1.47(a).

On 06 December 2001, USPTO mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) informing applicants that the application had gone abandoned for failure to timely respond to the Notification of Missing Requirements (Form PCT/DO/EO/905).

On 14 December 2001, applicants submitted faxed copies of the 23 October 2001 petition under 37 CFR 1.47(a), which were accompanied by, *inter alia*, a petition for a four-month extension of time; the fee for a four-month extension of time; a declaration of the inventors executed by Robert Arthur Sawhill; a declaration of Mr. Sawhill; and a copy of a letter to Mr. Shah and the registered article delivery receipt marked "Undeliverable." A copy of the Notification of Missing Requirements (Form PCT/DO/EO/905) was not included.

On 04 February 2002, the Office mailed Decision on Petition Under 37 CFR 1.47(a) dismissing applicants' petition without prejudice.

On 03 July 2002, applicants submitted a renewed petition with a petition for a three month extension of time and the fee for a three month extension of time.

On 25 October 2002, the Office mailed Decision On Petition Under 37 CFR 1.47(a), dismissing applicants' petition without prejudice.

On 25 October 2004, applicants submitted a petition to revive an unintentionally abandoned application.

On 23 November 2004, the Office mailed Decision On Petition Under 37 CFR 1.47(a), dismissing applicants' petition without prejudice.

On 14 March 2005, applicants submitted the instant renewed petition accompanied by a declaration of the previously non-signing inventor and the fee for a two month extension of time.

DISCUSSION

A petition to revive an abandoned application under 37 CFR 1.137(b) must be filed without intentional delay from the time the application became abandoned and/or applicant first became aware of the abandoned status of the application. A petition under 37 CFR 1.137(b) must be accompanied by (1) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, (2) the required reply, (3) the petition fee required by law (37 CFR 1.17(m)), and (4) a terminal disclaimer and fee (if the international application was filed prior to June 8, 1995). Pursuant to 37 CFR 1.137(b)(3), additional information may be required where there is a question whether the delay was unintentional.

Items (1), (3) and (4) were previously satisfied.

Item (2) has now been satisfied. A declaration in compliance with 37 CFR 1.497(a)-(b) is a proper reply. The 14 March 2005 declaration and the 23 April 2001 declaration, in combination, comply with 37 CFR 1.497(a)-(b).

CONCLUSION

Applicants' petition under 37 CFR 1.137(b) is **GRANTED**.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for continued processing in accordance with this decision. The application has a date of 14 March 2005 under 35 U.S.C. §§371(c)(1), (c)(2) and (c)(4).

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